

REMARKS**Status of Claims**

Claims 25, 26, 36-39, 42, 43, 48-51, 54, 55, 58, 59, and 63-74 are pending after entry of this paper. Claims 25, 26, 36-39, 42, 43, 48-51, 54, 55, 58, 59, and 63-74 have been rejected. Claims 1-24, 27-35, 40-41, 44-47, 52-53, 56-57, and 60-62 have been cancelled without prejudice. Applicants reserve the right to pursue cancelled claims in a divisional or continuing application.

The Examiner is thanked for her time and helpful suggestions during a phone call with Brandon T. Schurter on Tuesday, August 5, 2008.

Claim 25 has been amended to delete the phrase "an amino acid sequence of SEQ ID NO: 5 in" and to add the phrase "wherein the specific binding is to the SEQ ID NO:5 portion of the polypeptide." No new matter is introduced with this amendment. Support is found throughout the specification and claims as filed, for example, in original claim 1; p. 13, line 11 – p. 14 line 11; p. 19, lines 22 – 34; and p. 24, lines 20-35.

Response to Rejection under 35 U.S.C. §102(e)

U.S. Publication No. US2003/0027275 (Baker et al.)

Claims 25, 26, 36-39, 42, 43, 48-51, 54, 55, 58, 59, and 63-74 stand rejected under 35 U.S.C. §102(e) for allegedly being anticipated by U.S. Publication No. US2003/0027275 to Baker et al. ("US2003/0027275"). Applicants respectfully disagree with the Examiner's contention that a prima facie case of anticipation has been

established with US2003/0027275. Specifically, the prosecution history of US2003/0027275 reveals that applying the priority information on the face of the published application to SEQ ID NO: 466 would be inappropriate. Specifically, the published application discloses over 600 sequences and claims priority to dozens of U.S. and foreign cases. When the US2003/0027275 application was prosecuted, the applicants amended the priority information to cover the sequence being pursued. First, when US2003/0027275 was prosecuted, a protein other than SEQ ID NO: 466 was pursued and the priority information was amended accordingly. Second, in a related application, claims directed to SEQ ID NO: 466 *were* pursued with a different set of priority dates (which are later than that of the instant application). It is inappropriate to assert that a prima facie case has been established on the basis of this evidence.

The prosecution history of US2003/0027275 (U.S. Application No. 10/176,918) ("the '918 application") shows that: (1) Baker et al. deleted claims that were directed to SEQ ID NO:466, which is the only sequence at issue in the present Office Action; and (2) Baker et al. amended the priority of the '918 application to a date later than the date published in US2003/0027275. Specifically, Baker et al. admitted that the new priority information provided support for the claimed subject matter of the '918 application, which was not SEQ ID NO:466. Applicants for the instant application submit herewith several exhibits, for the convenience of the Examiner, in support of their position.

During prosecution, two preliminary amendments were submitted at the time the '918 application was filed. In one of the preliminary amendments, Baker et al. cancelled claims 1-24 and added new claims 25-30. New claims 25-30 were directed to

an antibody that binds to the polypeptide shown in Figure 118 (SEQ ID NO:118) (see Exhibit 1, page 6). Notably, none of the claims are directed to antibodies directed to SEQ ID NO:466 (SEQ ID NO:466 is the only polypeptide sequence at issue in the present Office Action; see Office Action mailed 4/21/08, page 2). In the second preliminary amendment, Baker et al. amended the specification to change the priority information from what was originally published in US2003/0027275. Specifically, the preliminary amendment requested that the previously filed priority be deleted and replaced with the following:

This application is a continuation of, and claims priority under 35 USC §120 to, US Application 10/052586 filed 1/15/2002, which is a continuation of, and claims priority under 35 USC §120 to, PCT Application PCT/US01/06520 filed 2/28/2001, which is a continuation-in-part of, and claims priority under 35 USC §120 to, US Application 09/380138 filed 8/25/1999, now abandoned, which is the National Stage filed under 35 USC §371 of PCT Application PCT/US99/05028 filed 3/8/1999, which claims priority under 35 USC §119 to US provisional application 60/0810780 filed 4/8/1998 (Exhibit 2, pages 1-2).

The applicants submit that a prima facie case, that US2003/0027275 is anticipatory art, has not been established. During prosecution of the '918 application (1) Baker et al. deleted claims that were directed to SEQ ID NO:466, which is the only sequence at issue in the present Office Action; and (2) the amended priority of the '918 application claimed the benefit of only the claimed invention, which was not SEQ ID NO:466. Moreover, Baker et al. contended during prosecution that priority may go back to PCT Application PCT/US99/05028 filed 3/8/1999 and to US provisional application

60/0810780 filed 4/8/1998 for SEQ ID NO:118 (PRO940 protein), however, neither PCT/US99/05028 nor 60/081,070 mention SEQ ID NO:466 (PRO1891 protein). Thus, the applications to which US2003/0027275 claims priority do not provide adequate support for, or disclosure of, SEQ ID NO:466 (PRO1891 protein).

Applicants respectfully request withdrawal and reconsideration of the 35 U.S.C. §102(e) rejection based on US2003/0027275 in view of the above-mentioned remarks.

U.S. Patent No. 7,314,913

U.S. patent no. 7,314,913 ("913 patent") is related to the '918 application and clearly points to a priority date for SEQ ID NO:466 (PRO1891) that is after that of the present case. The '913 patent issued from an application that is related to the '918 application described above (*i.e.*, both the '913 patent and the '918 application are continuations from U.S. Application No. 10/052,586).

The claims of the '913 patent are directed to isolated polypeptides of SEQ ID NO:466 (PRO1891 protein), which is the polypeptide sequence that is at issue in the present Office Action. Applicants respectfully direct the Examiner's attention to the '913 patent at column 1, lines 3-9, which sets forth the priority information for the claimed subject matter:

This application is a continuation of, and claims priority under 35 USC §120 to, U.S. application Ser. No. 10/052,586 filed Jan. 15, 2002, now abandoned, which is a continuation of, and claims priority under 35 USC §120 to, PCT Application PCT/US01/06520 filed Feb. 28, 2001, which claims priority under 35 USC § 119 to U.S. provisional application

60/187,202 filed Mar. 3, 2000. (emphasis added).

Thus, the earliest priority date for SEQ ID NO:466 is March 3, 2000.

The 1999 priority dates of the instant application pre-date the 2000 priority date of the '913 patent. Specifically, the instant application is a divisional of U.S. Application No. 09/548,797, filed on April 13, 2000 (now U.S. Patent No. 6,683,165), and claims the benefit of U.S. Provisional Application Serial Nos. 60/129,391 and 60/146,336, filed April 13, 1999 and June 30, 1999, respectively. Moreover, the specification of both provisional applications disclose and describe Gene 216, which is the gene that encodes SEQ ID NO: 5 (see *e.g.*, 60/129,391 at Table 3, last row and 60/146,336 at p. 1, line 32 – p. 3, line 22; table 6, and Figure 22.1-22.79). Additionally, the specification and sequence listing of at least the April 13, 1999 application disclose nucleotides, proteins, and antibodies as instantly claimed (see *e.g.*, 60/129,391 at p. 4, lines 21-26; p. 10, lines 10-17; p. 16, lines 13-21; p. 18, line 15 – p. 20, line 2; and SEQ ID NO: 17). Thus, the claimed antibodies of the instant invention are entitled to the April 13, 1999 date.

Therefore, applicants respectfully submit that neither US2003/0027275 nor the '913 patent anticipate the instant claims and, as such, applicants assert that the claims are patentable over the art.

CONCLUSION

Based on the foregoing remarks, the applicants respectfully request reconsideration and withdrawal of the pending rejections and allowance of this application. The applicants respectfully submit that the instant application is in condition

for allowance. Action passing this case to issue is therefore respectfully requested. In the event that a telephone conference would facilitate examination of this application in any way, the Examiner is invited to contact the undersigned at the number provided. Favorable action by the Examiner is earnestly solicited.

AUTHORIZATION

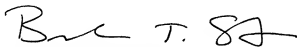
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. **13-4500**, Order No. 2976-4039US3.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. **13-4500**, Order No. 2976-4039US3.

Respectfully submitted,
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Dated: September 22, 2008

By: _____



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